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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. HICKMAN and JAMES J. GOUGH

Appeal 2012-006426
Application 09/625,300
Technology Center 2100

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1, 14-17, 31, 32 and 36. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The following claims illustrate the invention on appeal:

1. An automated electronic filing system comprising:
 - a web server coupled to the Internet;
 - a receiving agency server separate from said web server and coupled to the Internet such that it is capable of communication with said web server, wherein communication between said receiving agency server and said web server is subject to authentication and is at least partially encrypted;
 - a client machine separate from said web server and said receiving agency server and coupled to the Internet for communication with said web server, wherein communication between said client machine and said web server is subject to authentication and is at least partially encrypted, wherein said web server provides said client machine with a form which can be verified by said web server using heuristics, said client machine providing information to said web server forming at least a part of an electronic document to be filed with said receiving agency server by said web server in a manner that said web server serves as an interface to said receiving agency computer for said client machine, said electronic document filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible; and
 - wherein said web server automatically produces at least a portion of said electronic document in response to a selection originating from said client machine, wherein said form includes at least one of a blank form and a partially filled-in form based upon information stored on said web server, wherein said form can be at least partially automatically filled-in in response to said selection, wherein said web server automatically updates docketing information, and wherein said web server transacts a financial transaction with said receiving agency server on behalf of said client machine.

36. A communications system comprising:
a client computer coupled to the Internet;
an applicant computer coupled to the Internet and communicating with said client computer;
an intermediary server coupled to the Internet communicating with said client computer, said client computer serving as an intermediary between said applicant computer and said intermediary computer; and
a recipient server coupled to the Internet and communicating with said intermediary server, said intermediary server serving as an interface between said client computer and said recipient server,
whereby said recipient server communicates with said intermediary server as if said recipient server were communicating directly with said applicant computer.

REJECTIONS

Claim 36 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Takano (US Patent No. 6,434,580 B1, iss. Aug. 13, 2002).

Claims 1 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takano and Brown (US Patent No. 6,671,805 B1, iss. Dec. 30, 2003).

Claims 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takano and Daleen (US Patent No. 6,493,722 B1, iss. Dec. 10, 2002).

DISCUSSION

We will decide the appeal of independent claim 36 individually. Based on the dependencies of the claims, we will decide the appeal of claims 1, 14-17, 31, and 32 on the basis of independent claims 1, 31, and 32.

INDEPENDENT CLAIM 36

The issue before us follows: Did the Examiner err in finding that Takano teaches "an applicant computer . . . communicating with said client computer; an intermediary server . . . communicating with said client computer, said client computer serving as an intermediary between said applicant computer and said intermediary computer; and a recipient server . . . communicating with said intermediary server, said intermediary server serving as an interface between said client computer and said recipient server, whereby said recipient server communicates with said intermediary server as if said recipient server were communicating directly with said applicant computer[.]" as recited by independent claim 36?

The Examiner finds that the claimed "applicant computer," "client computer," "intermediary server," and "recipient server" respectively read on computer 100, computer 200, computer 300, and item 1000, which appears to be a network, of Figure 15 of Takano. (Ans. 14.) The Examiner also describes some of the functions performed by the reference's computers. (*Id.*)

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Here, we agree with the Appellants that the Examiner has not shown that Takano "teach[es] the elements of an applicant computer – client computer intermediary computer - recipient computer arranged such they communicate through the Internet in a chained manner[.]" (Appeal Br.12),

i.e., in the claimed manner. For example, the Examiner does not allege, let alone show, that computer 100 communicates with computer 200. Nor have we found a teaching to that effect.

"The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Here, the Examiner cites to Takano's entire claim 2 to support his finding that an intermediary server communicates with item 1000 of Figure 15. (Ans. 14.) Claim 2, however, uses different terminology than that of Figure 15, and the Examiner does not explain the correspondence of the two disclosures. Furthermore, the Examiner fails to identify which part of claim 2 allegedly teaches the claimed limitation. Nor have we found a teaching to that effect.

The Appellant also argues that "*Takano* does not teach the limitation that the recipient computer communicates with the intermediary server as if it were communicating directly with the applicant computer." (Appeal Br. 12.) Regarding this limitation, the Examiner again cites to item 1000 of Figure 15 and all of claim 2, without explaining the correspondence of the two disclosures or identifying which part of claim 2 allegedly teaches the claimed limitation. We decline to resort to speculation to make up for the Examiner's deficiencies.

Therefore, we conclude that the Examiner erred in finding that Takano teaches "an applicant computer . . . communicating with said client computer; an intermediary server . . . communicating with said client computer, said client computer serving as an intermediary between said

applicant computer and said intermediary computer; and a recipient server . . . communicating with said intermediary server, said intermediary server serving as an interface between said client computer and said recipient server, whereby said recipient server communicates with said intermediary server as if said recipient server were communicating directly with said applicant computer[.]" as required by independent claim 36.

INDEPENDENT CLAIMS 1, 31, AND 32

The issue before us follows. Did the Examiner err in finding that Takano teaches "that said web server serves as an interface to said receiving agency computer for said client machine[.]" as recited by independent claim 1, and similarly required by independent claims 31 and 32?

We agree with the Appellants that the Examiner has not shown that "**Takano** . . . provide[s] [a] web server forming a 'middle-man' between the receiving agency computer and the client machine." (Appeal Br. 14.)

The Examiner finds that Takano discloses that "the web server serves as an interface between the client machine and the receiving agency server (claim 2)" (Ans. 11.) The Examiner fails to identify which part of relied upon claim 2 allegedly teaches the claimed limitation. Furthermore, the Examiner previously mapped the claimed web server, client machine, and receiving agency server to elements of Figure 15. As mentioned *supra*, relied upon claim 2 uses different terminology than that of Figure 15, and the Examiner does not explain the correspondence of the two disclosures. We decline to resort to speculation to make up for the Examiner's deficiencies.

The Examiner does not allege, let alone show, that the addition of the other applied references cures the aforementioned deficiency of Takano.

Therefore, we conclude that the Examiner erred in finding that Takano teaches "that said web server serves as an interface to said receiving agency computer for said client machine[.]" as recited by independent claim 1, and similarly required by independent claims 31 and 32.

DECISION

We reverse the rejections of claims 1, 31, 32, and 36 and those of claims 14-17, which depend from claim 1.

REVERSED

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